

Notice of Allowability

Application No.

10/079,130

Applicant(s)

MEAGHER ET AL.

Examiner

Art Unit

ILIA OUSPENSKI

1644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 5/15/2006.
2. ☒ The allowed claim(s) is/are 1 - 4, 17, 19 - 22, 27 - 38, 42, 88 - 89, 112 - 116, 120 - 121, 130 - 138, and 148 - 150, renumbered 1 - 43.

3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All b) ☐ Some* c) ☐ None of the:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.

5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.

(a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached

1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.

(b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.

Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).

6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|---|--|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input checked="" type="checkbox"/> Interview Summary (PTO-413),
Paper No./Mail Date <u>8/1/2006</u> . |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO-1449 or PTO/SB/08),
Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit
of Biological Material | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____. |

DETAILED ACTION

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed on 05/15/2006 in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 05/15/2006 has been entered.

2. Applicant's amendments/remarks, filed 05/15/2006, are acknowledged.

Claims 5 – 16, 18, 23 – 26, and 117 – 119 have been cancelled previously.

Claims 1 – 4, 17, and 130 – 136 have been amended.

Claims 1 – 4, 17, 19 – 22, 27 – 116, 120 – 150 are pending.

Claims 35 – 41, 43 – 111, 122 – 129, and 139 – 147 have been withdrawn from consideration by the Examiner as being drawn to nonelected inventions.

3. Claims 1 – 4, 17, 19 – 22, 27 – 34, 42, 112 – 116, 120 – 121, 130 – 138, and 148 – 150 are directed to an allowable product. Pursuant to the procedures set forth in MPEP § 821.04(b), **claims 35 – 38 and 88 – 89**, directed to the process of making or using the allowable product, previously withdrawn from consideration as a result of a restriction requirement, **are hereby rejoined** and fully examined for patentability under 37 CFR 1.104. Claims 39 – 41, 43 – 87, 90 – 111, 122 – 129, and 139 – 147, directed to methods that do not include all the limitations of an allowable product claim, or to patentably distinct products, have NOT been rejoined.

Because a claimed invention previously withdrawn from consideration under 37 CFR 1.142 has been rejoined, **the restriction requirement between groups I and II as set forth in the Office action mailed on 09/17/2004 is hereby withdrawn.** In view of the withdrawal of the restriction requirement as to the rejoined inventions, applicant(s) are advised that if any claims including all the limitations of an allowable product claim or rejoined process claim are presented in a continuation or divisional application, such claims may be subject to provisional statutory and/or nonstatutory double patenting rejections over the claims of the instant application. Once the restriction requirement is withdrawn, the provisions of 35 U.S.C. 121 are no longer applicable. See *In re Ziegler*, 443 F.2d 1211, 1215, 170 USPQ 129, 131-32 (CCPA 1971). See also MPEP § 804.01.

It is noted that claims 39 – 41, previously included in Group II (see restriction requirement mailed on 09/17/2004) are directed to a method wherein a surface-expressed antibody receptor is mutated, and as such, do not include all the limitations of the allowable product claims. Claims 90 and 91, also initially included in Group II, depend on product claim 43, which has been included in Group III and has not been considered in the instant application. Therefore, claims 39 – 41 and 90 – 91, although initially listed as part of Group II, have not been rejoined with the allowable claims of Group I.

4. An Examiner's Amendment to the record appears below. Should the changes and/or additions be unacceptable to Applicant, an amendment may be filed as provided by 37 C.F.R. § 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the Issue Fee.

5. Authorization for this Examiner's Amendment was given by Lizette Fernandez in a telephone interview with the Examiner on 08/01/2006.

Examiner's Amendment

In the Specification:

6. The TITLE has been replaced with -- METHOD OF RAPID PRODUCTION OF HYBRIDOMAS EXPRESSING MONOCLONAL ANTIBODIES ON THE CELL SURFACE --

In the Claims:

7. Claims 39 – 41, 43 – 87, 90 – 111, 122 – 129, and 139 – 147 have been cancelled.

8. In claim 88, part “e,” the phrase “recognizes a specific antigen” has been replaced with -- recognizes the specific antigen -- .

Reasons for Allowance

9. The following is an Examiner's Statement of Reasons for Allowance:

The Examiner's Amendment set forth supra, in conjunction with Applicant's amendment and arguments filed 05/15/2006, and declaration filed under 37 CFR1.132 by Dr. Christine Milcarek, have obviated the previous rejection of record, mailed 11/15/2005.

Claims 1 – 4, 17, 19 – 22, 27 – 38, 42, 88 – 89, 112 – 116, 120 – 121, 130 – 138, and 148 – 150 are pending and allowed.

The prior art does not teach or suggest the claimed hybridoma cells or methods of making hybridoma cells.

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10. Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ILIA OUSPENSKI, Ph.D.

Patent Examiner

Art Unit 1644

August 2, 2006

Phillip Gambel
PHILLIP GAMBEL, PH.D. J.D.
PRIMARY EXAMINER
TC600
8h/06